

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): SAPIR, et al.  
Serial No.: 10/677,225  
Filed: October 3, 2003  
Title: A METHOD AND APPARATUS FOR DETECTING  
SUBSTANCE TO BE DETECTED CONTAINING AT LEAST  
ONE COMPONENT THAT IS DISPERSIBLE IN AIR IN THE  
FORM OF SOLID PARTICLES  
Group: 1797  
Examiner: SIEFKE, S.  
Confirmation No.: 8599

**PRE-APPEAL CONFERENCE PILOT PROGRAM REQUEST**  
**REASONS FOR REVIEW**

Mail Stop: AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

October 27, 2008

Sir:

Appellants request a pre-appeal brief conference based on the following clear errors in the Examiner's final rejection.

Claims 1-15 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over EP '057 in view of Jenkins et al. The rejection is clearly improper for the following reasons.

**The Examiner's Rejections of Claims 1-15 under 35USC103 (a) in the Final Office Action of July, 30, 2008**

On page 3 of the office action, the examiner makes an obviousness rejection of all the pending claims under 35 USC 103(a) as being unpatentable over EP 0169057 (hereinafter Ep '057) in view of Jenkins et al USPN 6,642,513 (hereinafter

“Jenkins”). More specifically the Examiner states that “[t]he filter is a wire mesh coil that can be heated to vaporize the solid particles (page 17). The air stream 71 in the line 48 enters the center of the coil 70 and travels radially there through as indicated by arrows 72 (much like an automobile air filter). **This statement meets all limitations of the newly amended claim 1 the filter it is open at one opening where air flow 71 enters then exits through the filter and not through the back side of the filter which is closed.**” (Emphasis added). The examiner then states that “Ep’057 does not teach a filter that comprises a woven fabric or a non-woven fabric.... Jenkins teaches materials for the detection of contraband that comprises filters that are made of woven fabric, non-woven fabrics and fabrics made of plastic materials (col. 2, line 59-col 3, line 17).... Therefore it would have been obvious to one having an ordinary skill in the art at the time of the invention to modify Ep’057 to employ the fabrics of Jenkins because it is well known in the art that specific fabrics are capable of being heated to high temperatures thereby vaporizing any solid substances trapped therein which allows for vapor detection of the sample.”

Finally on page 4 and in response to applicant’s arguments “fully considered but not deemed to be persuasive,” the Examiner says “Ep ‘057 states, ‘The collector 62 performs the function of collecting, i.e. trapping particulates located in the air stream entering the collector. This can be accomplished in many various ways. For example the collector 62 may be a conventional cyclone. Alternatively; it may be a rolled coil 70 of wire mesh as shown in fig. 10.’ ‘Other forms of collector may also be used.’ It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Ep ‘057 to employ a filter probe because through routine experimentation, one would have looked to various designs of filters because they all fulfill the same purpose, e.g. to collect a particulate in a gas sample.”

### The Interview with the Examiner on October 22, 2008

An interview was held, by the Applicants' US Patent Attorney Alan E. Schiavelli and EP Patent Attorney Gerard Portal, with the Examiner on October 22, 2008, during which the Examiner recognized that **"EP'057 does not teach the specific structure of an outer casing, and a hollow tube that is closed at one end"** (emphasis added), but the Examiner repeated the same statements as set forth in the Office action and repeated above.

### Applicants' Reasons for Review

It is apparent that, by stating in the office action that **"[t]his [namely the EP '057] statement meets all limitations of the newly amended claim 1 the filter it is open at one opening where air flow 71 enters then exits through the filter and not through the back side of the filter which is closed"** (emphasis added), the Examiner has clearly overlooked the structural limitations which are in pending amended claim 1 filed on October 2, 2007. Indeed, pending claim 1 now recites the following technical feature:

said filter comprising **a hollow tubular outer casing** containing a filter-forming element **which is supported on a central element that is likewise in the form of a hollow tube that is closed at one end so as to prevent air from passing through and to oblige air to pass through the filter-forming element.** (Emphasis added).

Ep '057 does not disclose such a structure as claimed, which was admitted by the Examiner at the interview. Accordingly, this claimed structure is not disclosed in Ep '057, and the Examiner's statement that all the limitations of the Applicants' amended claim 1 are met is clearly improper.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The “EXAMINATION GUIDELINES FOR DETERMINING OBVIOUSNESS UNDER 35 U.S.C. 103” set forth in the Manual of Patent Examining Procedure (MPEP) §2141, indicate that even though “[t]he prior art reference (or references when combined) need not teach or suggest all the claim limitations, however, **Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.**” (Emphasis added). While the Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, 82 USPQ2d 1385 (2007) noted “the need for caution in granting a patent based on the combination of elements found in the prior art,” the Examiner has not shown here that all the elements of applicants’ claimed invention are found in the prior art. To the contrary, as admitted by the Examiner, the prior art does not disclose **the specific structure of an outer casing, and a hollow tube that is closed at one end.**

In addition, **Applicants’ claimed structure is clearly unobvious** over the filter structures disclosed by Ep ‘057, and notably in the embodiment of Fig 10. The Examiner has not provided any apparent reason to modify the prior art to provide **the specific structure of an outer casing, and a hollow tube that is closed at one end.** To the contrary, as it appears from Ep ‘057 Fig 10, the prior art structure requires that “[t]he air stream 71 in the line 48 **enters the center of the coil 70 and travels radially therethrough as indicated by arrows 72 (much like an automobile filter)**” (emphasis added). See, page 17 lines 3 to 6 of Ep ‘057. The air flow in Ep ‘057 is entirely different from that provided by the filter structure as claimed.

Indeed, with the filter structure as claimed, **the air is prevented from passing through and enters laterally and from the outside is obliged to travel longitudinally on a significant part of the filter** which is sandwiched between the closed central tube and the outer tubular casing. See applicants' specification on page 9, lines 22- 25 and Figures 1, 2, and 2A). Accordingly, the **invention air travel of the air through the filter is unobviously different from that of the prior art.**

This provides, in an unobvious manner, a secure holding of the filter while ensuring a better trapping efficiency of the filter. Note that in the prior art use of a sticky substance coating appears to be necessary (see Ep '057 at page 17, lines 6 to 11). There is no need for such a sticky substance in the invention filter structure which in fact has to be avoided as requiring complex cleansing operations between successive testings.

For the foregoing reasons, the final rejection is clearly improper.

Respectfully submitted,

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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) 935.43189X00			
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____	Application Number  10/677,225	Filed  October 3, 2003			
	First Named Inventor  Sapir et al.				
	Art Unit  1797	Examiner  Siefke			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top; padding-bottom: 10px;"><p><input type="checkbox"/> applicant/inventor.</p><p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p><p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>32,087</u></p><p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p></td><td style="width: 50%; vertical-align: top; padding-bottom: 10px;"><p><u>/Alan E. Schiavelli/</u> _____ Signature</p><p><u>Alan E. Schiavelli</u> _____ Typed or printed name</p><p><u>703-312-6600</u> _____ Telephone number</p><p><u>October 27, 2008</u> _____ Date</p></td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>32,087</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>	<p><u>/Alan E. Schiavelli/</u> _____ Signature</p> <p><u>Alan E. Schiavelli</u> _____ Typed or printed name</p> <p><u>703-312-6600</u> _____ Telephone number</p> <p><u>October 27, 2008</u> _____ Date</p>
<p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>32,087</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>	<p><u>/Alan E. Schiavelli/</u> _____ Signature</p> <p><u>Alan E. Schiavelli</u> _____ Typed or printed name</p> <p><u>703-312-6600</u> _____ Telephone number</p> <p><u>October 27, 2008</u> _____ Date</p>				
<p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>					

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